

## REMARKS

Claims 15, 16, and 20 have been rewritten as new claims 21, 22, 23, and 24 by canceling the former and adding the latter. Claim 19 has been rewritten as new claim 25, directed, however, to pharmaceutical compositions.

It is not believed that any additional fee is due for the presentation of claims 21-25 but in the event a fee is deemed to be due, authority is hereby given to charge such deficiency to Deposit Account No. 13-2165.

The Examiner has required restriction between Groups I through III. Group I encompasses those claim referring to one or more of formulas 1, 2, 3, 6, and 7 while Group II encompasses those claim referring to either formula 4 or formula 5. Group III relates to claims 17 and 18 defining processes. In addition, the Examiner has required election of a single compound with identification of an exact definition for each substituent in the base molecule.

For the reasons set forth below, Applicants respectfully traverse both the restriction requirement and the election requirement. In view of the strictures of 37 CFR §1.143, however, Applicants elect Group II and further elect the single compound of Formula 4 in which each of R, R<sup>1</sup>, and R<sup>2</sup> is hydrogen, X is oxygen, and Y and Z together are oxygen; *i.e.*, compound 4a disclosed in Example 7 on page 14 of the specification. In furtherance of these actions, claims 15 and 16 have been rewritten as new claims 21 and 23, claim 20 has been rewritten as new claim 24, and the elected species has been specifically claimed in new claim 22. The claims that read upon claim 22 are 21 and 24. It is believed claim 23 also falls within Group II. If, notwithstanding the traversal set forth below, the

restriction requirement is maintained, claims 17, 18, and 25 would correspond to non-elected subject matter.

Notwithstanding the required elections, Applicants submit that election is not appropriate. First, and with respect to the compounds encompassed by Groups I and II, these are derivatives of epothilone A, epothilone B, epothilone C, or epothilone D. Epothilone A and epothilone C differ from epothilone B and epothilone D, respectively, solely by a methyl group in the 12-position. The principal point of structural difference in the claimed compounds is the nature of the substituent in the 15-position; the fundamental epothilone nucleus, a sixteen member lactone ring having common substitution in positions 1, 3, 4, 5, 6, and 7, remains the same in both of Groups I and II. Common and art-recognized substitution patterns similarly are found in positions 12 and 13 in both sets of compounds. The compounds moreover have the same utilities. Concerning process claims 17 and 18, both claims utilize the same conditions and reactants and differ only in the nature of the starting material.

As to claim 25, this is directed to pharmaceutical compositions utilizing one of four recognized classes of compounds designated by formulas 2, 3, 6, and 7 (see claims 1-4 in Applicants US Patent No. 6,288,237). As such, these compounds are believed to be properly encompassed by a single claim.

In summary, Applicants believe they are entitled to a patent but do believe they should be forced to prosecute and maintain a plurality of patents on what is submitted to be a single inventive entity. While election may be permissible for purposes of examination, it is submitted that this application, already the second divisional application based upon the original parent application, Serial No.

09/077,055 (filed over five years ago in 1998), should not be subject to additional restriction.

Favorable reconsideration is earnestly solicited.

Respectfully Submitted,  
MATHEWS, COLLINS, SHEPHERD & McKAY, P.A.  
Attorneys for Gerhard Hoefle *et al.*

By: Bruce M. Collins  
Bruce M. Collins *mc*  
Reg. No. 20,066

February 2, 2004

MATHEWS, COLLINS, SHEPHERD & McKAY, P.A.  
100 Thanet Circle, Suite 306  
Princeton, NJ 08540  
Tel. (609) 924-8555  
FAX (609) 924-3036